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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Burl Finkelstein) Group Art Unit: 3676
Serial No. 10/045,373) Examiner: Barrett, Suzanne
Filed: January 15, 2002)
For: WALK-IN FREEZER DOOR)
AND DOORFRAME SYSTEM)
AND DOORLOCK)

APPEAL BRIEF

I. INTRODUCTION

This is an appeal from the decision of the Patent Examiner, Group Art Unit 3676, finally rejecting claims 2 and 5 in the subject application.

II. REAL PARTY IN INTEREST

The Applicant is the real party in interest.

III. RELATED APPEALS AND INTERFERENCES

None.

IV. STATUS OF THE CLAIMS

Claims 2 and 5 stand rejected by the final action mailed November 25, 2003. Claims 2 and 4 are pending. Applicant hereby appeals the final rejection of claims 2 and 5.

V. STATUS OF AMENDMENTS

No amendments are pending.

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VI. SUMMARY OF INVENTION

Applicant has invented a walk-in freezer door and doorframe system comprising a doorjamb having sheets of metal covering a body of thermal insulation, a door mounted to the doorjamb, a deadbolt housing mounted to the outside of the doorjamb, a deadbolt mounted for reciprocal movement within the housing between a door locked and a door unlocked position, a handle rotatably positioned inside of the doorjamb from which a shaft extends into the deadbolt housing and into operative association with the deadbolt and with a longitudinal portion of the handle shaft being made of a low thermal conductive plastic. The system also includes a mounting plate with at least one counterbored mounting hole to which the handle shaft rotatably extends, the mounting plate being mounted flush to the inside of the doorjamb by at least one metallic mounting bolt having a head mounted in the mounting plate counterbored mounting hole, a cap made of a low thermally conductive plastic mounted in the mounting plate counterbored hole covering the mounting bolt head; and a keeper mounted to the door in a position to receive the deadbolt with the door located within the doorjamb.

VII. ISSUES

The issues in the Appeal are whether Claims 2 and 5 are unpatentable under 35 USC §103 by Finkelstein et al. 5,582,443 in view of Hoyt et al. 4,669,282 and Hoebing 4,099,754.

VIII. GROUPING OF CLAIMS

Claim 2 stands and falls alone.

Claim 5 stands and falls alone.

Claim 2 differs from claim 5 as claim 2 is directed to an entire door system while claim 5 is directly only to a lock.

IX. ARGUMENT

The Examiner has initially stated that Finkelstein has an outer deadbolt lock means 22, an inner handle means 17 and a shaft 21/17 comprised of a metal portion 21 and an insulated low thermal conductive plastic portion 17. It is submitted that this is incorrect.

Firstly, the lock 22 of Finkelstein is not a deadbolt. Rather it is a cylinder lock, see Col 3, line 8. Though the statement is made at Col 3, lines 40-43 that the locking assembly can be used in connection with cylinder locks in door handles and in other exterior locks such as deadbolt-type locks, just how that would be done is not disclosed. Of course cylinder locks and deadbolt locks per se have both been well known for a very long time.

Secondly, the inner handle means 13 is not the handle of Finkelstein. It is a latch, see Col 2, line 36. The Finkelstein handle is handle 36, see Col 3, line 9, which is rotatably mounted outside the door.

Thirdly, the shaft (rod) 21 of Finkelstein does not have an insulated low thermal conductive plastic portion 17. Element 17 is a bolt. See Col 2, lines 43 and 64. It forms no portion of the shaft. Rather it has a keyway "for receiving a rotatable, metallic rod 21", Col 2, line 48. The rod is made of a metal or fiberglass, Col 3, lines 32-33.

Fourthly, the positioning of the lock to the doorjamb and not to the door is important. With a lock mounted to a door the lock goes through temperature changes as it is moved from a door closed position wherein the lock is in direct contact with the cold interior of the freezer to a door open position wherein the lock is in direct contact with the warmer air outside the freezer. This change in temperature can cause condensation within the locking mechanism which can freeze and thereby hamper the operation of the lock. Applicant's lock on the other hand is mounted to the doorjamb, thus, the lock does not undergo vast temperature differences which may cause condensation. This is an improvement of the Finkelstein et al. patent.

With regard to Hoebing, it discloses a security latch that

has a lag bolt anchored in the timbers of a door frame of a room in public places such as motels and hotels. It includes a strip of molding 93 that overlays a nut 92. There is nothing in the reference related to refrigeration or thermal insulation or conduction. Indeed, there is no mention of the material that the molding is made of although one would assume that it is wood molding since the door and door frame are made of wood. For a hotel it would be strange to use plastic molding for aesthetics.

Accordingly, it is submitted that claims 2 and 5 as now rewritten are patentable over Finkelstein in view of Hoyt and further in view of Hoebing. There would be no motivation to combine the teachings of Hoebing which is concerned with hotel security, not with freeze-up. Moreover, even were the three references to be combined they would still fail to produce the walk-in freezer door of claims 2 and 5.

It is well settled that the obviousness of an invention cannot be established by combining the teaching of the prior art absent some teaching, suggestion or incentive supporting the combination, see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *Pentec, Inc. v Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed.Cir. 1985). Moreover, the mere fact that the prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art fairly suggests the desirability of the modification, see *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, neither Finkelstein et al., Hoyt et al. nor Hoebing suggest any motivation for, or the desirability of, the changes suggested by the examiner. As such, it is improper to combine these references to establish obviousness.

It is acknowledged that the tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from

the prior art. MPEP 2142. This is "especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'". *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). With this in mind, a hindsight-based obviousness analysis must be supported by evidence which is "clear and particular". *In re Dembiczak*. It is insufficient to simply offer a broad range of sources or to make conclusory statements, as "[b]road conclusory statements regarding the teaching of multiple references, standing along, are not 'evidence'". *Id.* Applicant respectfully submits that the examiner has claimed the present invention to be obvious utilizing hindsight and conclusory statements. Applicant respectfully contends that the invention of claims 2 and 5 are not obvious, but instead is novel and therefore worthy of patent protection.

CONCLUSION

For these reasons, the undersigned respectfully submits that the claimed invention is not obvious by the references of record. For the reasons recited above, it is respectfully submitted that the claims are allowable.

The requisite fee due upon filing of this brief is attached. Any additional fee is to be charged to Baker, Donelson, Bearman, Caldwell and Berkowitz, P.C., Deposit Account No. 11-0553.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on July 14, 2004.

Signature Patty Y. Cordero

APPENDIX A APPLICANT'S CLAIMS

2. (Currently amended) A walk-in freezer door and doorframe system comprising a doorjamb having sheets of metal covering a body of thermal insulation, a door mounted to said doorjamb, a deadbolt housing mounted to the outside of said doorjamb, a deadbolt mounted for reciprocal movement within said housing between a door locked and a door unlocked position, a handle rotatably positioned inside of said doorjamb from which a shaft extends into said deadbolt housing and into operative association with said deadbolt and with a longitudinal portion of said handle shaft being made of a low thermal conductive plastic; a mounting plate with at least one counterbored mounting hole to which said handle shaft rotatably extends, said mounting plate being mounted flush to the inside of said doorjamb by at least one metallic mounting bolt having a head mounted in said mounting plate counterbored mounting hole, a cap made of a low thermally conductive plastic mounted in said mounting plate counterbored hole covering said mounting bolt head; and a keeper mounted to said door in a position to receive said deadbolt with the door located within said doorjamb.

5. (Currently amended) A lock for a walk-in freezer door comprising:

a deadbolt assembly comprising a housing adapted to be mounted on a cooler doorjamb, a bolt mounted for reciprocal movement within said housing between a door locked and a door unlocked position, means manually accessible from inside the cooler for moving said bolt and which includes a rotatable shaft a longitudinal portion of which is made of a low thermal conductivity material, at least one metallic mounting bolt having a head for mounting said deadbolt assembly to the cooler doorjamb, a cap made of a low thermal conductivity material for covering and thermally insulating said mounting bolt head, and

a keeper adapted to be mounted on a door in a position to receive said bolt with the door when located in a closed position.